

REMARKS

Claims 6 and 27 are canceled without prejudice, and claims 40 to 44 are added, and therefore claims 1 to 5, 7 to 26, and 28 to 44 are now pending. Applicants respectfully request reconsideration of the present application in view of this response.

With respect to the objection to claim 2, claim 2 has been corrected, as suggested. Withdrawal of the objection to claim 2 is therefore respectfully requested.

Claims 1, 2, 3 and 4 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,411,952 to Bharat et al. ("the Bharat reference").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

While the rejections may not be agreed with, to facilitate matters, claim 1 has been revised to include the features of canceled claim 6. It is respectfully submitted that Bharat does not identically describe (or even suggest) the features of canceled claim 6 and therefore does not anticipate claim 1 as presented, or claims that depend from claim 1, including claims 2, 3 and 4. Withdrawal of the anticipation rejections with respect to Bharat is therefore respectfully requested.

Claims 5, 6 and 7 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of U.S. Patent No. 6,353,831 to Gustman ("the Gustman reference").

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (*See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), *cert. denied*, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990)).

The features of canceled claim 6 have been included in claim 1, as explained above.

Claims 5 and 7 depend from claim 1 as presented, and it is therefore respectfully submitted that Bharat and Gustman references do not disclose a server arrangement, as provided for in the context of claim 1 as presented, which assigns at least one document content identifier to each data record transmitted by the server arrangement. The Office Action asserts on page 4 that “Gustman teaches, 'Each catalogue element has an associated ID (e.g., an integer ID) that uniquely identifies the catalogue element.'” It is respectfully submitted, however, that the “associated ID” referred to by Gustman is not a **content** identifier, as recited in claim 1, but instead simply an identifier whose intended purpose is to uniquely identify the catalogue element rather than describe its content. Indeed, the example of an “integer ID” provides no hint of the contents of the catalogue element and instead only enables a simple sequential indexing scheme. Accordingly, the references relied upon, whether taken alone or combined, do not disclose a server arrangement, as provided for in the context of claim 1 as presented, which assigns at least one document content identifier to each data record transmitted by the server arrangement, so that dependent claims 5 and 7 are allowable.

The Office Action also asserts that “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bharat with the teachings of Gustman and include a method to have a content identifier for each record with the motivation to provide the user with a convenient method of retrieving data”, but such an assertion is clearly a mere desire for a convenient method of data retrieval, which would not lead one having ordinary skill in the art to modify Bharat in the manner contemplated by claim 1, as presented.

In this regard, to the extent that the Examiner maintains the unsupported “ordinary skill” statements regarding those rejections, it is respectfully requested pursuant to 37 C.F.R. § 1.104(d)(2) that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also M.P.E.P. § 2144.03). Otherwise, if the Examiner cannot provide either references or an affidavit to support the contentions now made, it is respectfully requested that the rejections of the claims under 35 U.S.C. § 103(a) be withdrawn for this reason alone.

In sum, it is therefore respectfully submitted that claim 1 as presented, and its dependent claims 5 and 7 are allowable over the applied references for at least these reasons. Accordingly, the obviousness rejections of these claims should be withdrawn.

Claims 8, 9 and 19 to 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of U.S. Patent No. 6,513,031 to Fries et al. (“the Fries reference”).

While the rejections may not be agreed with, to facilitate matters, the features of canceled claim 27 (like canceled claim 6) have been included in claim 19.

With respect to the rejection of claims 8, 9 and 19 to 26 under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of Fries, it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Fries reference does not cure the critical deficiencies of the Bharat reference (as explained above) with respect to claim 1 as presented, from which claims 8 and 9 ultimately depend. Indeed, the Office Action does not assert that Fries cures the deficiencies of Bharat as applied against claim 1 as presented. Claim 19 as presented includes the features of canceled claim 27, and is therefore allowable for essentially the same reasons as claim 1 as presented. It is therefore respectfully submitted that claims 8, 9 and claim 19, and its dependent claims 20 to 26 are allowable for at least the same reasons that claim 1 is allowable. Accordingly, withdrawal of the obviousness rejections of claims 8, 9 and 19 to 26 is respectfully requested.

Claims 10 to 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of Fries in further view of U.S. Patent No. 5,897,670 to Nielsen (“the Nielsen reference”).

With respect to the rejections of claims 10 to 15 under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of Fries in further view of Nielsen, it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Fries and Nielsen references do not cure the critical deficiencies of the Bharat reference (as explained above) with respect to claim 1 as presented, from which claims 10 to 15 depend. Indeed, the Office Action does not assert that Fries or Nielsen cures the deficiencies of Bharat as applied against claim 1. It is therefore respectfully submitted that claims 10 to 15 are allowable for at least the same reasons that claim 1 is allowable. Accordingly, withdrawal of the obviousness rejections of claims 10 to 15 is respectfully requested.

Claims 16 to 18 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of Fries in further view of Nielsen in further in view of U.S. Patent No. 5,890,147 to Peltonen (“the Peltonen reference”).

With respect to the rejections of claims 16 to 18 under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of Fries in further view of Nielsen in further view of Peltonen, it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Fries, Nielsen and Peltonen references do not cure the critical deficiencies of the Bharat reference (as explained above) with respect to claim 1, from which claims 16 to 18 ultimately depend. Indeed, the Office Action does not assert that Fries, Nielsen or Peltonen cures the deficiencies of Bharat as applied against claim 1 as presented. It is therefore respectfully submitted that claims 16 to 18 are allowable for at least the same reasons that claim 1 as presented is allowable. Accordingly, withdrawal of the obviousness rejections of claims 16 to 18 is respectfully requested.

Claims 27 to 29 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of Fries in further in view of Gustman.

The features of canceled claim 27 have been included in claim 19.

With respect to the rejection of claims 28 and 29 under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of Fries in further view of Gustman, it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Fries and Gustman references do not cure the critical deficiencies of the Bharat reference (as explained above) with respect to claim 19 as presented, which explained above, from which claims 28 and 29 depend. Indeed, the Office Action does not assert that Fries or Gustman cures the deficiencies of Bharat as applied against claim 19 as presented. It is therefore respectfully submitted that claims 28 and 29 are allowable for at least the same reasons that claim 19 as presented is allowable. Accordingly, withdrawal of the obviousness rejections of claims 28 and 29 is respectfully requested.

Claims 30 to 35 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of Fries in further view of Gustman in further view of Nielsen.

With respect to the rejections of claims 30 to 35 under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of Fries in further view of Gustman in further view Nielson, it is respectfully submitted that even if it were proper to combine the references as suggested

(which is not conceded), the secondary Fries, Gustman and Nielsen references do not cure the critical deficiencies of the Bharat reference (as explained above) with respect to claim 19 as presented, as explained above, from which claims 30 to 35 ultimately depend. Indeed, the Office Action does not assert that Fries, Gustman and Nielsen cures the deficiencies of Bharat as applied against claim 1 as presented. It is therefore respectfully submitted that claims 30 to 35 are allowable for at least the same reasons that claim 1 as presented is allowable. Accordingly, withdrawal of the obviousness rejection of claims 30 to 35 is respectfully requested.

Claims 36 to 39 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of Fries in further view of Gustman in further view of Nielsen in further view of Peltonen.

With respect to the rejections of claims 36 to 39 under 35 U.S.C. § 103(a) as unpatentable over Bharat in view of Fries in further view of Gustman in further view of Nielsen in further view of Peltonen, it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Fries, Gustman, Nielsen, and Peltonen references do not cure the critical deficiencies of the Bharat reference (as explained above) with respect to claim 19 as presented, from which claims 36 to 39 ultimately depend. Indeed, the Office Action does not assert that Fries, Gustman, Nielsen, and Peltonen cures the deficiencies of Bharat as applied against claim 19 as presented. It is therefore respectfully submitted that claims 36 to 39 are allowable for at least the same reasons that claim 19 as presented is allowable. Accordingly, withdrawal of the obviousness rejections of claims 36 to 39 is respectfully requested.

As further regards the obviousness rejections, it is respectfully submitted that a *prima facie* case of obviousness has not been made in the present case, since the Office Action never made any findings, such as, for example, regarding what the ordinary skill level in the art would have been at the time the claimed subject matter of the present application was made. (See In re Rouffet, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying a *prima facie* obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)).

It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the

problem to be solved as a whole would have suggested to those of ordinary skill in the art,” and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone.” (See In re Kotzab, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing In re Dembiczak, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art,” the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is again respectfully submitted that there has been no such showing by the Office Action.

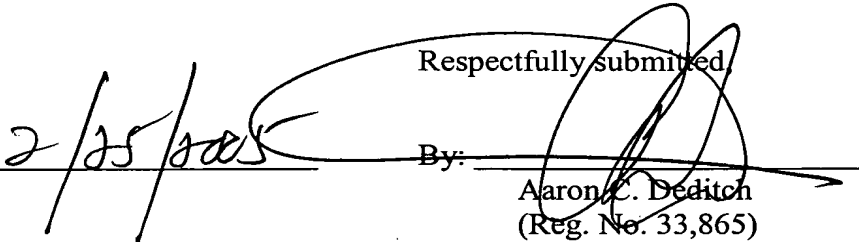
In fact, it is again respectfully submitted that the lack of any of the required factual findings in the Office Action forces Applicants to resort to unwarranted speculation to ascertain exactly what facts underly the present rejections. The law requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Office has failed to carry the initial burden of presenting a proper prima facie case of obviousness. (See In re Oetiker, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

New claims 40 to 43 do not add any new matter and are fully supported by the present application, including the Specification. Claims 40 to 44 depend, directly or indirectly, from claim 1 as presented and are therefore allowable for at least the same reasons that claim 1 as presented is allowable. For example, claim 44 is allowable for the further reason that none of the cited references disclose, or even suggest, defining a user class based on a common industry, a common role, or common business objective; mapping each data record to the user class by a domain expert based on the assigned content identifiers and the common industry, role, or business objective; connecting data records directly to the users based on their common industry, role, or business objective; receiving feedback from the users regarding the records they are connected with; and updating the assigned document content identifiers assigned to each data record. Hence, according to the present claimed subject matter data records are connected with users based on the “use category” of the data.

In summary, it is respectfully submitted that claims 1 to 5, 7 to 26 and 28 to 44 are allowable for the foregoing reasons.

CONCLUSION

In view of all of the above, it is believed that the objections and rejections have been obviated, and that present claims are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

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